

Interview Summary	Application No. 10/771,766	Applicant(s) VRUDHULA ET AL.	
	Examiner Tamthom N. Truong	Art Unit 1624	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Tamthom N. Truong. (3)_____.
- (2) Shah Makujina. (4)_____.

Date of Interview: 02 December 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: All claims of record.

Identification of prior art discussed: N/A.


Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Makujina elected Group I from the restriction of 10/044,183 (parent case).

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.



Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Currently,
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group I
12/2/05*
- I. Claims 1-3, 11, and 30 (in part), drawn to compounds of formula I wherein R^1 , R^2 , $X=Y$, and A together form a **tetrahydro-imidazo[1,2-a]-pyrimidinyl** ring, classified in class 544, subclasses 281.
- II. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein R^1 , R^2 , $X=Y$, and A together form a **triazacyclopenta[a]indenyl** ring, classified in class 548, subclasses 258, 262.4.
- III. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein R^1 , R^2 , $X=Y$, and A together form a **tetraazacyclopenta(α)indenyl** ring, classified in class 548, subclass 250.
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- IV. Claims 1, 11, and 30 (in part), drawn to compounds of formula I wherein R^1 , R^2 , $X=Y$, and A together form an **imidazo[1,2-a]imidazole**, classified in class 548, subclasses 302.4, 303.1.
- V. Claim 31, drawn to a method of treating various disorders comprising the administration of a pharmaceutical composition comprising a compound of formula I, classified in class 514, subclasses 259.3, 267, 293, 303, and 393.
- Further restriction will be required if this group is elected.
- VI. Claims 32 and 33 (in part), drawn to compounds, and the process of making formula (WHH). Further restriction will be required if this group is elected.

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VII. Claims 34-37 (in part), drawn to compounds, and the process of making formula (Z'), classified in various classes and subclasses. Further restriction will be required if this group is elected.

VIII. Claims 1-10 (in part), and 12-29 (in part), drawn to the remaining compounds of formula (I) that do not belong to the above groups, classified in various classes, and subclasses. Further restriction will be required if this group is elected.

2. The inventions of groups I-IV and VI-VIII differ from each other because each group is drawn to a ring system that is distinct and patentable over each other. Essentially, these are seven independent inventions as compounds of one group can be utilized alone, and not in combination of those in other groups. Note, with a variable core as such, the common property is not enough to keep seven groups in the same Markush claim. Furthermore, a prior art that renders obvious one invention would not do so to the others. Thus, restriction for examination purpose as indicated is proper. However, should applicant traverse on the ground that the seven groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the seven groups to be obvious variant or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the invention unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other inventions.

Inventions Groups I-IV, and VI-VIII vs. the invention of Group V are related as product and method of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the method for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different method of using that product (MPEP § 806.05(h)). In the instant case the method of treating various disorders can be done using other commercially available drugs such as Prozac, Tylenol, Procardia, Clomiphene, etc.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II - VIII, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Shah R. Makujina on 5-9-03 a provisional election was made with traverse to prosecute the invention of Group IV, claims 1, 11, and 30 (in part). Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-10, and 31-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. In claim 1, the definition of R^2 as $D'-D''(R^3)(R^4)$ is unclear. When D' is a bond, it appears that there is a double bond between D'' and Y. However, in the chemical structure of formula (I), R^2 is singly bonded to Y. Thus, it is not clear what is intended.
- b. The last proviso in claim 1 does not seem to make sense because Z^1 is never CE^2 .

Claim Objections

4. Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

The IDS of 4-12-02 and 7-22-02 have been considered. The cited references seem relevant to the non-elected subject matter only.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Tamthom N. Truong
Examiner
Art Unit 1624

May 26, 2003